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09/699,396	10/31/2000	Shyam S. Bayya	79693	9262

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EXAMINER

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17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliance
With 37 CFR 1.192(c)**

Application No.

09/699,396

Applicant(s)

BAYYA ET AL.

Examiner

Michael Cleveland

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 04 April 2003 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192 (c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENTIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☒ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
 - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c) (7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☒ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

See attached

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NOTICE OF DEFECTIVE APPEAL BRIEF

1. The appeal brief is defective because it does not address all of the rejections present in the case.
2. The brief does not contain, for each rejection under 35 U.S.C. 112, (first paragraph), an argument which specifies errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including how the specification and drawings, if any, enable any person skilled in the art to make and use the full scope of the subject matter defined by each of the rejected claims.
3. The brief does not contain, for each rejection under 35 U.S.C. 112, (second paragraph), an argument which specifies the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. A complete summary of the rejections remaining in the case follows:
 - A. Claims 5, 14, and 16-17 are rejected under 35 USC 112, 2nd paragraph for two reasons: The clarity of claim 14 and the units on the dilution ratio in claims 5, and 16-17. (See Advisory Action, Paper No. 14, p. 3). An amendment to cancel claim 14 and to properly include units in claims 5 and 16-17 (The presently proposed amendment of claims 5 and 16-17 are NOT acceptable because they introduce the unclear language "coating solution or precursor solution".) would be entered, if presented in a separate paper, and would resolve these issues.
 - B. Claims 1, 3-8, and 11-19 are rejected under 35 USC 112, 1st paragraph for lack of enablement. Applicant has not addressed this issue.
 - C. Claim 14 is separately rejected for lack of enablement. Claim 20 is separately rejected for lack of enablement. An amendment to cancel claim 14, and an amendment to include "sodium phosphate" in the list of precursors of claim 20 would resolve the latter two issues.
 - D. Claims 1, 3 and 13-14 are rejected under 35 USC 103(a) as being unpatentable over Petersen '100 in view of Strom '607, Anderson '922, and Okabe '911.
 - E. Claims 3-8, 12, 15-19 are rejected under 35 USC 103(a) as being unpatentable over Petersen '100 in view of Strom '607, Anderson '922, and Okabe '911, as applied to claims 1 and 13, and further in view of Masters.

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F. Claims 10 and 20 are rejected under 35 USC 103(a) as being unpatentable over Petersen '100 in view of Strom '607, Anderson '922, Okabe '911, and Masters, as applied to claims 8 and 13, and further in view of Hanneman '267 and Chau '229.

G. Claim 11 is rejected under 35 USC 103(a) as being unpatentable over Petersen '100 in view of Strom '607, Anderson '922, Okabe '911, Masters, Hanneman '267, and Chau '229, as applied to claim 10, and further in view of Ohoshi '184.

Issues A. and C. may be addressed by amendment.

Newly Withdrawn Issues

5. The rejection of claim 13 under 35 USC 112, 2nd paragraph is withdrawn. The rejection of the phrase "to improve integrity" is withdrawn in view of the plain meaning of the word "integrity". Merriam-Webster's Collegiate Dictionary, 10th edition, defines "integrity" as "an unimpaired condition: SOUNDNESS". In light of this plain meaning the phrase "heat-treating the coating material...to improve integrity" has been treated as inclusive of any heat treatment which causes the coating to become more suitable (sound) for its intended purpose.

6. The rejection of claims 4 under 35 USC 112, 2nd paragraph over the term "velocity" is withdrawn in view of the plain meaning of the term, which is defined by Merriam-Webster's Collegiate Dictionary, 10th edition, as "quickness of motion: SPEED". (Claims 5 and 16-17 are no longer rejected for this issue, but remain rejected because of the units of the dilution ratio, as described above.

7. The changes are as follows: the Examiner withdrew the rejection of 35 USC 102 of claims 1, 13, and 14 as anticipated by Petersen because Applicant convincingly argued that Petersen teaches gellation (Paper No. 14, p. 4). The Strom, Anderson, and Okabe references were cited as rendering prevention of gellation/precipitation obvious. However, two parallel sets of rejections were present: a first set based on Petersen alone, and a second set based on Petersen in conjunction with Strom, Anderson, and Okabe. All of the first set of rejections should have been withdrawn in Paper No. 14. Accordingly, the rejections of claims 3-8, 12, and 15-19 based on Petersen in view of Masters, of 10 and 20 further in view of Hanneman and Chau, and 11 further in view of Ohoshi are withdrawn. That is, **issues (b), (d), and (f) listed in the appeal brief are withdrawn.**

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8. The appeal brief is also defective because it does not contain a correct copy of the appealed claims in part because the proposed After Final amendment filed 4/4/2003 has not been entered. The examiner notes that the clean copy and marked-up copy of claim 1 of the After Final amendment do not agree with each other, and neither agrees with the version in the Appeal Brief. Even if the amendment had been entered, some claims would still not agree with the claims as presented in the Appeal Brief (e.g., claims 4 and 20).

Response to After Final response dated 4/4/2003:

9. The proposed After Final amendment will not be entered because it raises new issues for further search and consideration, because Applicant's proposed amendments to claims 1 and 13 would raise the issue of clarity under 35 USC 112, 2nd paragraph for the reasons given in the prior advisory action. Further, the amendment to claim 13 would raise new issues for further search and consideration because it would narrow the scope of the claims by removing the phrase "and/or to improve integrity of the coating".

Response to Arguments

10. Applicant's arguments filed 4/4/2003 in the After Final amendment have been fully considered but they are not persuasive.

Applicant's arguments of unexpected results in the After Final amendment are unconvincing because Applicant does not the After Final amendment does not assert what particular unexpected results are achieved. The assertion is unsupported by evidence commensurate in scope with the claims. Furthermore, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant's response that

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preventing gelation would not have been obvious does not address the clear motivation of Strom '607, Anderson '922, and Okabe '911.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cleveland whose telephone number is (703) 308-2331. The examiner can normally be reached on 8-5:30 M-F, with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-3186 for regular communications and (703) 306-3186 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MBC

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June 29, 2003



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